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TRANSMITTAL FORM

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nine

Total Number of Pages in This Submission: 9

Application Number	09/896,542
Filing Date	6/29/2001
First Named Inventor	Pepi Dakov
Art Unit	3731
Examiner Name	Gary Jackson
Attorney Docket Number	———

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☒ Amendment/Reply
- ☒ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ After Allowance communication to Technology Center (TC)
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) (please Identify below):

Remarks

Response to Office Action of 9/23/2004 including set of amended claims.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Pepi Dakov
Signature	Pepi Dakov
Date	Oct 12, 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Pepi Dakov		
Signature	Pepi Dakov	Date	Oct 13, 2004

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Application No: 09/896,542
Applicant: Pepi Dakov
Filing Date: 6/29/2001
Examiner: Gary Jackson
Art Unit: 3731

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to office action of Sep. 19, 2004, mailed on Sep. 23, 2003:

In the second office action of Sep.19, 2003, mailed on Sep. 23, 2004, the examiner has made a final rejection of claims 24-46 on the grounds of two reasons:

First, claims 24-46 were rejected under – 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter – the claims recite the connector device positively with "anatomical structure".

Second, claims 24-46 were rejected under the judicially created doctrine of obviousness-type double patenting.

Each of these two reasons presents new grounds for rejection that were not expressed in the first office action of 03/16/2004.

1. Applicant requests the examiner to reconsider the final rejection as premature and to withdraw the finality of the rejection because these two new grounds for rejection were not necessitated by the applicant's amendment.

The second office action should not have been made final as the examiner has introduced new grounds of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP 706.07(a).

The facts forming the new grounds for the two rejections were not introduced by the applicant's amendment. There were present in the original claims.

Connector device was recited positively with "anatomical structure" in the original claims 1-23. There was no objection, rejection, or implication for such in the first office action for this matter.

In the same way, all of the grounds for rejection of claims 24-46, under the judicially created doctrine of obviousness-type double patenting, were also present in the original claims 1-23. Furthermore, the new amended claims have added limitations and therefore provide less ground for such a rejection than the original claims. Again, there was no objection, rejection, or implication for such in the first office action for this matter.

As the new grounds for rejections in the second office action were not necessitated by the applicant's amendment, the finality of the second office action should be withdrawn.

2. Finality of the second office action should be withdrawn as premature, as the applicant was not given enough time to respond to these issues discussed in the examiner's phone call on Sep 15, 2004.

In this call the examiner advised the applicant of his intention to reject the claims based on two reasons: first, under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter (the connector device was positively recited with anatomical structure), and second - on the grounds of double patenting.

In the discussion over the phone, examiner suggested that the rejection of the claims under 35 U.S.C. 101 can be avoided if the term "anatomical structure" is

replaced with "structure" throughout the claims. Applicant agreed to the proposed amendment and authorized the examiner to perform the amendment. Applicant specifically asked the examiner was a letter showing the applicant's agreement to these amendments needed. The examiner answered that an oral agreement is enough. Applicant remained with the impression that this issue was resolved and he did not need to take action on this matter.

On the issue of double patenting, the applicant told the examiner that he was not sure if a terminal disclaimer was really needed as this is a continuation-in-part application that automatically expires 20 years from the filing date of the parent application, in this case US Pat. 6,030,392. When advised by the examiner that a terminal disclaimer is needed despite the fact that this is a continuation-in-part application, the applicant agreed to file a terminal disclaimer in several days after researching the topic and the procedure of doing this.

Four days after the phone call on Sep 19, 2004, the examiner signed on final rejection on the grounds of the two issues and the office action was mailed on Sep. 23, 2004.

As the applicant was not given sufficient time to respond the examiner call and the examiner actions differ from the agreement made on the phone, the finality of the second office action should be withdrawn as premature.

3. The rejection of claims 24-46 under the judicially created doctrine of obviousness-type double patenting should be withdrawn, as the applicant signed on Sep17, 2004 and mailed on Sep. 21, 2004 two terminal disclaimers, which precedes the examiner second action on Sep. 19, 2004 mailed on Sep. 23, 2004.

4. Two terminal disclaimers signed on Sep 17, 2004 and mailed on Sep 21, 2004 should overcome the double patenting rejection. First, a terminal disclaimer that disclaims the term of the current application No. 09/896,542 filed on 06/29/2001 in reference to Pat. No. 6,030,392 filed on 05/19/1997 was filed. A second terminal disclaimer that disclaims the term of US Pat. No. 6,254,618 filed on 01/08/2000 in reference to US. Pat. No, 6,030,392 filed on 05/19/1997 was also filed.

The current application is continuation-in-part of both patents 6,030,392 and 6,254,618. As the current application was disclaimed in reference to 6,030,392, and patent 6,254,618 was disclaimed in reference to 6,030,392, a disclaimer for the current application in reference to 6,254,618 was considered redundant and was not filed however such can be promptly submitted on examiners request if necessary.

5. The rejection of the claims 24-46 under 35 U.S.C. 101 should be withdrawn. As explicitly expressed by the examiner in his phone call and in the office action, the claims do contain allowable subject matter. Therefore, the claims should not have been rejected but objected.

6. Applicant is submitting new amended claims deleting the term "anatomical" throughout the claims, as suggested by the examiner to overcome this rejection under 35 U.S.C. 101.

Applicant confirms his agreement that the examiner can perform all necessary amendments to make the claims allowable. The examiner may accept the submitted amended claims or perform new amendments as appropriate.

Conclusion:

Applicant requests withdrawal of the finality of the second office action.

Applicant has taken all the steps suggested by the examiner to overcome the rejections of the second office action.

Applicant can be reached by phone at: work (212) 746-2355 during hours 9:00AM – 5:00PM, mobile (718) 614-4138, home (718) 897-3732, or by email at dakovs@hotmail.com.

Sincerely,

Pepi Dakov, M.D

Date: 10/12/2004